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| 09/202,305      | 03/22/1999  | NICHOLAS MANOLIOS    | 06025.0003          | 2721             |

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EXAMINER

GUPTA, ANISH

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 07/29/2002

*ll*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/202,305

Applicant(s)

NICHOLAS MANOLIOS

Examiner

Anish Gupta

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-14 is/are pending in the application.
- 4a) Of the above claim(s) 4, 9-11 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 6 and 13 is/are rejected.
- 7) ☒ Claim(s) 5, 7-8, 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The request filed on 5-6-02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/202,305 is acceptable and a CPA has been established. An action on the CPA follows.

Along with the request for the CPA, applicants filed an amendment filed, amending claims 1 and 11 and canceling claim 15. Claims 1, 3-14 are pending in this application.

### *Election/Restriction*

2. Applicant's election with traverse of Group I and the species of SEQ ID. No. 7 in Paper No. 7 and 13 is acknowledged.

Thus, as indicated in the previous office action, allo ability was established for the species corresponding to SEQ ID NO: 6-15 and 17-26. The search was extended in the Markush group and a peptide was found that read on generic claim 1. Although claims 4, 9-11 and 14 were examined with respect to SEQ ID. No 6-15 and 17-26, they were held as non-elected since they did not read on the elected species found in the prior art. Note that under species examination a claim can be held, even though the elected species may have read on the said claim, as non-elected.

As stated in the previous office action, claims 1-3, 6, 13 have been examined to the extent they read on the prior art. Claims drawn to the nonelected species, claims 4, 9, 10-11, 14 are held withdrawn from further consideration.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 6, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Sitkovsky et al

The claims are drawn hydrophobic peptide and therapeutic composition thereof of which the below peptide are within the scope of the present claims.


The reference teaches the peptide PLSRTLVS or PLRRTLVSAA-NH<sub>2</sub> that read on the claimed peptide. Note that the three amino acid sequence PLS or PLR would qualify as the first X variable, the R residue (the second R residue in the PLRRTLVSAA sequence) correspond the Z residue, and the TLSVS AND TLSVAA read on the second X variable. Both of the peptides reading on the X variable comprise amino acids that are hydrophobic and are at least 50% of the amino acid making up the hydrophobic peptide (amino acids P and L in the PLS or PLR and amino acids T, L, V in the TLSVS and amino acids T, L, V, A in the TLSVAA). Finally, The claimed language of "T-cell antigen receptor (TCR) function" is an intended use limitation and intended use or field of use. However, intended use limitation and intended use or field of use for the invention generally will not limit the scope of a claim. Moreover, where the claimed and prior art products are identical or substantially identical in structure or composition, a prima facie case of either anticipation or obviousness has been established. In re Best, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 15

USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best, supra*. Therefore, the reference anticipates the claimed invention.

4. Claims 5, 7-8, and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Gupta whose telephone number is (703) 308-4001. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can normally be reached on (703)308-2923. The fax phone number of this group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
KAREN COCHRANE CARLSON, PH.D  
PRIMARY EXAMINER

Anish Gupta

July 23, 2002